

Appl. No. 10/551,072
Amdt. Dated August 9, 2007
Reply to Final Action of May 9, 2007

REMARKS

Claims 1 to 3, 5 to 8 and 11 to 15 are currently pending in the present application. Claims 1, 8 and 13 are amended herein. Claim 4 is cancelled. No new matter is added by the amendments. Reconsideration of the present application, as amended, under 37 C.F.R. 1.116 is respectfully requested.

Claims 1 to 3, 5, 8, 11 and 13 stand rejected by the Action under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2004/0029834 to Schiestel et al. (hereinafter “Schiestel”). Applicants respectfully submit that Schiestel does not expressly or inherently disclose all of the elements set forth in independent claims 1, 8 and 13. Thus, Schiestel does not anticipate claims 1, 8 and 13 or claims 2 to 3, 5 and 11, which depend therefrom.

Claim 1 now clearly claims a medical apparatus comprising at least one surface which is at least partially coated with a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent.

Schiestel does not disclose a medical apparatus coated with a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises tetraethoxysilane. As disclosed by the subject application on page 3, lines 14 to 15, a coating which comprises tetraethoxysilane exhibits good resistance to iodine-containing compositions. Thus, the invention of claim 1 yields a product having a high

cross-link density. This high density prevents cracking of the coating. Schiestel is silent on the presence or prevention of cracks in the disclosed product, let alone the use of tetraethoxysilane for producing a high density coating for preventing such cracks.

Schiestel also does not disclose a medical apparatus coated with a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises methyltromethoxysilane. The subject application discloses, at page 3, lines 21 to 23, that in order to further avoid the development of cracks in the disclosed medical apparatus, the organosilane compound comprises methyltromethoxysilane (MTMS). The use of methyltromethoxysilane is particularly effective for preventing cracks if the coatings are thicker than approximately 500 nm.

Finally, Schiestel does not disclose a medical apparatus coated with a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises an organic, polymerizable substituent. As disclosed in the subject specification at page 4, lines 2 to 8, the use of an organic, polymerizable substituent enables a high cross-link density to be achieved, without the coating exhibiting cracks, so that resistance to emollients may be achieved.

Independent claims 8 and 13, similar to claim 1, also claim a coating made of a hydrolytically condensed organosilane composition, wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic,

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polymerizable substituent. Accordingly, claims 8 and 13 are patentable over Schiestel for at least the reasons discussed with respect to claim 1.

Dependent claims 2, 3, 5, 11 and 14 depend from claims 1, 8 and 13 and provide further features, thus claims 2, 3, 5, 11 and 14 are clearly distinguishable over Schiestel for at least the reasons discussed. Accordingly, the Applicants respectfully request that the rejections under 35 U.S.C. § 102(e) of claims 1 to 3, 5, 8 to 11, 13 and 14 be withdrawn.

Claims 4, 7 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schiestel. Claim 4 is cancelled. Accordingly the rejection of claim 4 is moot. Claim 1, from which claim 7 depends, now claims a medical apparatus comprising at least one surface which is at least partially coated with a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent. Claim 8, from which claim 12 depends, now claims a medical apparatus comprising at least one surface which includes a hydrolytically condensed organosilane sol-gel iodine-resistant coating comprised from a material with the formula $SiX_pY_qZ_r$, wherein X is a hydrolytically condensable substituent, Y is a polymerizable substituent R-A, wherein R is an alkylene or arylalkylene, and A is selected from the group comprising halogen, amino, amide, aldehyde, alkylcarbonyl, carboxy, thio, cyano, alkoxy, alkoxycarbonyl, sulfonic acid, phosphoric acid, acryloxy, methacryloxy, epoxy or vinyl, and Z is a hydrolytically non-condensable and non-polymerizable substituent, and wherein p is

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equal to 2, 3, or 4, q is equal to 0, 1, or 2, and r is equal to 0 or 1, and wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent.

As discussed, Schiestel does not disclose a coating made of a hydrolytically condensed organosilane sol-gel composition wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent. In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As discussed above, the cited combination fails to suggest all elements of claims 1 and 8, as amended. Thus, claims 7 and 12 are patentable over Schiestel for at least the reasons discussed with respect to claims 1 and 8.

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Schiestel in view of U.S. Patent Application No. 2003/0157344 to Shoup et al. (hereinafter “Shoup”). Applicants respectfully point out that Shoup, similar to Schiestel, fails to disclose a coating made of a hydrolytically condensed organosilane composition, wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent, as is now claimed by claim 1, from which claim 6 depends. Thus, the combination of Schiestel and Shoup fails to disclose all of the claim limitations of claim 1, let alone claim 6. Accordingly, it is submitted that claim 6 is patentable over the combination of Shoup and Schiestel. Withdrawal of the rejection of claim 6 under 35 U.S.C. 103(a) is earnestly requested.

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Claims 13 to 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent Number 6,001,163 to Harvey et al. (hereinafter “Harvey”). Claim 13 now claims a process for making medical equipment resistant to iodine comprising coating one or more surfaces with a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent. Harvey does not disclose a coating made of a hydrolytically condensed organosilane sol-gel composition, wherein the organosilane composition comprises tetraethoxysilane, methyltromethoxysilane, and an organic, polymerizable substituent. As discussed above, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Harvey fails to suggest all elements of claim 13. Thus, claim 13, and claims 14 to 15, which depend therefrom and add further features, are patentable over Harvey for at least the reasons discussed. Withdrawal of the rejection of claims 13 to 15 under 35 U.S.C. 103(a) is earnestly requested.

Accordingly, reconsideration of the present application, as amended, under 37 C.F.R. 1.116 and allowance of claims 1 to 3, 5 to 8 and 11 to 15 is earnestly solicited.

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Conclusion

In view of the foregoing, Applicants respectfully submit that the specification, the drawings and all claims presented in this application are currently in condition for allowance. Accordingly, Applicants respectfully request favorable consideration and that this application be passed to allowance.

Should any changes to the claims and/or specification be deemed necessary to place the application in condition for allowance, the Examiner is respectfully requested to contact the undersigned to discuss the same.

Applicants' representative believes that this response is being filed in a timely manner. In the event that any extension and/or fee is required for the entry of this amendment the Commissioner is hereby authorized to charge said fee to Deposit Account No. 14-1270. An early and favorable action on the merits is earnestly solicited.

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If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call David Barnes, Esq., Intellectual Property Counsel, Philips North America Corporation at the number below.

Respectfully submitted,

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